Remarks

This Amendment is responsive to the Office Action of June 4, 2004. Reexamination and reconsideration of **claims 1-29** is respectfully requested.

Summary of The Office Action

Claim 19 was rejected under 35 U.S.C. 112, second paragraph, and was indicated to be allowable if rewritten to overcome the rejection under U.S.C. 112, second paragraph.

Claims 1-2, 5, 7, 9, 10, 14-17, 20 and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bardmesser, US Patent No. 5,986,992.

Claims 1-2, 5, 7, 8-10, 14-17, 20 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art in the background of the current invention in view of Bardmesser, US Patent No. 5,986,992.

Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Bardmesser or the background and Bardmesser as applied to claim 1 above, and further in view of Barney et al., US Patent No. 6,212,512.

Claims 3, 6, 12, 13, and 18 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Present Claims Patentably Distinguish Over the References of Record

The 102 Rejection

Claim 1 has been amended to clarify that the removable data storage device is configured to determine and store the file usage data. Conversely, Bardmesser teaches that a computer or other data processing device, not a removable data storage device, determines properties of a

disk cartridge. For example, Bardmesser teaches that the computer determines the capacity of a disk cartridge and the amount of unused capacity on the disk 3 (see column 3, lines 39-42). Bardmesser provides no suggestion that the disk is capable of determining its own file usage data, but instead must rely on a computer to provide such information. Bardmesser further confirms this by stating that the disk controller 24 of the disk "...instructs the computer to determine the unused capacity of the disk 3." (see column 3, lines 63-65).

Therefore, Bardmesser fails to teach or suggest a removable data storage device that is configured as recited in claim 1. Since claim 1 recites features not taught or suggested by the reference, claim 1 patentably distinguishes over Bardmesser. Accordingly, dependent claims 2-9 also patentably distinguish over the reference and are in condition for allowance.

Independent claim 10 recites self-scanning, determining file characteristics, and determining and accumulating file usage information, which are performed by the removable data storage device.

Bardmesser fails to teach or suggest that the removable data storage device performs the recited elements of claim 10. Rather, Bardmesser teaches that a computer or other data processing device determines the capacity of an inserted disk 3 (see column 3, lines 39-42). The disk is not capable of performing self-scanning or the other claimed elements, and Bardmesser provides no suggestion to the contrary.

Thus, Bardmesser fails to teach or suggest claim 10 and claim 10 patentably distinguishes over Bardmesser. Accordingly, dependent claims 11-15 also patentably distinguish over the reference and are in condition for allowance.

Regarding independent claim 16, claim 16 recites that a removable data storage device comprises...a scan logic and a file usage data structure.

The Office Action points to Bardmesser, column 3, lines 38-45, to teach the scan logic. However, this section of Bardmesser clearly describes that a computer or other data processing device determines the capacity of the disk. There is no teaching or suggestion that the disk includes the claimed scan logic or has any component that can analyze file management

information contained within the disk. Bardmesser only teaches that a computer is used to read data from the disk and provide capacity information.

Thus, Bardmesser fails to teach or suggest claim 16 and claim 16 patentably distinguishes over Bardmesser. Accordingly, dependent claims 17-21 also patentably distinguish over the reference and are in condition for allowance.

The 103 Rejection

Claims 1-2, 5, 7, 8-10, 14-17, 20 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art in the background of the current invention in view of Bardmesser, US Patent No. 5,986,992.

The Background of the present application states that when memory cards are transferred to a general purpose computer, the computer would perform file analysis to determine the attributes of the contents of the card's memory (see paragraph [0004]). As stated previously, Bardmesser describes a disk that when connected to a computer or other data processing device, the computer determines the capacity of the disk.

Therefore, the Background and Bardmesser describe similar systems where a storage device relies on the computer to perform analysis. As such, combining these teachings provides no further benefit to either system and still fails to teach or suggest the claimed features of the present independent claims. One of ordinary skill, upon reading these references, would find no suggestion to the contrary. The obviousness rejection thus cannot stand and should be withdrawn.
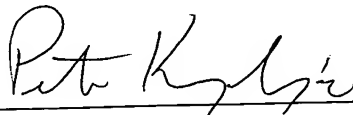
Non-Art Rejection

Claim 19 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Applicant points to paragraphs [0023], [0027] and [0028] as examples for supporting the language of claim 19. It is noted that the file management information may also contain data types and individual file sizes. But, the file usage information can include an amount of space occupied by a data type (e.g. amount of space used by all JPEG files). Therefore, the applicant believes claim 19 is definite and complies with 35 U.S.C. 112, second paragraph.

Conclusion

For the reasons set forth above, **claims 1-29** patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

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